

REMARKS

The cross reference to the related application and the objections under §112 have been overcome, it is submitted, by the above amendment.

These Remarks are directed to the rejection on the ground of double patenting. We attach hereto a copy of the decision of the Board of Patent Appeals and Interferences in Appeal No. 95-4121. Although this opinion states that it was "not written for publication", the appeal was from the same art unit as is involved in the present application and involves similar principles. The application under review in the Board's opinion was a reexamination of U.S. Patent No. 4,496,066. Certain claims of the reexamined patent were rejected under the judicially created Doctrine of Obviousness-type Double Patenting over the claims of an earlier patent of the same inventor in view of "Hunter" (a different inventor). Commencing at page 4 the Board considers obvious-type double patenting and reverses the Examiner on this ground.

It is believed that most of the comments of the Board are pertinent to the rejection on double patenting in the last Office Action in this case. There are three independent claims in the '763 patent. Claims 1, 11 and 12 are to the combination of a cap and a container.

Claim 1 of this application is directed only to a cap. In claim 1 commencing at the top of column 5, the '763 patent calls for a skirt formed with an internal screw thread, an enlarged diameter stretch, an internal locking bead positioned and dimensioned to engage the underside of the crown bead, at least one barrier integral with the skirt extending downward from the second screw thread and extending downward to a position to intercept the first screw thread to block unscrewing of the cap relative to the neck and also calls for second orientating means cooperable with first orientation means on the container so that when the cap is pushed axially downward on the neck, the first screw thread and the second screw thread are in registration. There is absolutely nothing in claim 1 of the present application directed to that subject matter. On the other hand, claim 1 of the present application calls for the top of the cap being formed with a central well and a score line extending along the side wall and across the bottom of the well, none of which appears in any claim of the '763 patent.

The Examiner can only reject on the ground of double patenting by comparing the claims of a pending application with the claims of a patent in a double patenting rejection.

The analysis used in an obviousness-type Double Patenting rejection is "similar to, but not necessarily the same as" the analysis employed in a rejection under 35 U.S.C. §103. *In re Bratt*, 937 F.2d 589, 592, 19 U.S.P.Q.2d 1289, 1292 (CAFC 1991). An important difference between the two types of rejections is that the prior patent must not be used as though it were prior art in the Double Patenting rejection." *General Foods Corp. v. Studiengesellschaft Kohle mbH*, 972 F.2d 1272, 1281, 23 U.S.P.Q.2d 1839, 1846 (CAFC 1992). The Examiner has improperly used only selected parts of the claims of the '763 patent rather than the invention defined by the '763 claims to reject the remaining claims on obviousness-type Double Patenting.

The court in *General Foods* wrote at 972 F.2d at 1279, 23 U.S.P.Q.2d at 1845:

The basic concept of double patenting is that the same invention cannot be patented more than once, which, if it happened, would result in a second patent which would expire some time after the original patent and extend the protection timewise. But double patenting law has always been more inclusive. Double patenting law principles extend to merely obvious variants of what has been patented. Step one of the analysis is to determine what that it. Claims are the determinants. (emphasis in original)

Before rejecting claims on Double Patenting, one must identify the invention claimed by the co-pending patent. The court in *General Foods* stated at 972 F.2d at 1280, 23 U.S.P.Q.2d at 1845:

[I]t is important to bear in mind that comparison can be made only with what invention is claimed in the earlier patent, paying careful attention to the rules of claim interpretation to determine what invention a claim defines and not looking to the claim for anything that happens to be mentioned in it as though it were an art reference. (emphasis in original)

Double Patenting analysis requires the comparison of the claims in question with the invention defined by the claims of the earlier patent.

The subject matter of the claims of the patent must not be used as a priori art reference.

Our precedent makes clear that the disclosure of a patent cited in support of a double patenting rejection cannot be used as though it were prior art, even where the disclosure is found in the claims.

972 F.2d at 1281, 23 U.S.P.Q.2d at 1846 (emphasis in original). See also *In re Kaplan*, 789 F.2d at 1574, 229 U.S.P.Q. (Fed. Cir. 1986); *In re Barfield*, 17 U.S.P.Q.2d 1885 at 1888 (Fed. Cir. 1991).

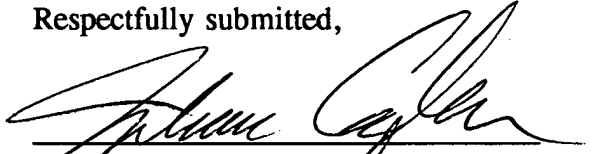
The doctrine of obviousness-type Double Patenting is designed to prevent a patent owner from obtaining a patent on an obvious modification of a patented invention. One must first identify the patented invention defined by the claims. *General Foods Corp. v. Studiengesellschaft Kohle mbH*, 972 F.2d 1272, 23 U.S.P.Q.2d 1839 (CAFC 1992). The claims of the prior patent are used to determine "what has been patented, the subject matter which has been protected, not for something one may find to be disclosed by reading" the claims. *In re Aldrich*, 398 F.2d 855, 859, 158 U.S.P.Q. 311, 314 (C.C.P.A. 1968).

Although we have been specific to claim 1, a review of cap claim 10 and combination claims 11 and 12 of the '763 patent shows absolutely no correspondence of the claims.

Therefore, reconsideration of the rejection is believed to be in order.

Since all of the other grounds of rejection have been overcome, it is believed that this application should be allowed.

Respectfully submitted,



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enclosure

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THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 21

MAILED

FEB 16 1996

PAT.&T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

FLEHR, HOHBACH, TEST
ALBRITTON & HERBERT
DOCKETED
RG-59077
FEB 26 1996

BY Wdy
RESPONSE DUE
ALL DATES ENTERED
SCHEDULE TO FOLLOW

Ex parte PORTOLA PACKAGING, INC.

Appeal No. 95-4121
Application 90/003,230¹

ON BRIEF

FLEHR, HOHBACH, TEST
ALBRITTON & HERBERT
1996 FEB 26 PM 2:53
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Before COHEN, LYDDANE and ABRAMS, Administrative Patent Judges.
COHEN, Administrative Patent Judge.

¹ Request filed October 27, 1992, Control No. 90/003,230, by Portola Packaging, Inc. for the Reexamination of Patent No. 4,496,066, issued January 29, 1985, based on Application 06/517,584, filed July 27, 1983.

Appeal No. 95-4121
Application 90/003,230

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1, 3 through 5, 7, and 8, all of the claims remaining in this reexamination proceeding for U.S. Patent No. 4,496,066.

Appellant's invention pertains to the combination of a neck for a container formed of flexible plastic material and a cap for engagement with the neck. A basic understanding of the invention can be derived from a reading of exemplary claim 1, a copy of which is appended to this opinion.

In rejecting appellant's claims, the examiner has relied upon the documents listed below:

Hunter et al. (Hunter)	3,204,799	Sept. 7, 1965
Faulstich	4,202,455	May 13, 1980
Bullock, III (Bullock '857)	4,438,857	Mar 27, 1984

The following rejections are before us for review.

Claims 1, 3 through 5, 7, and 8 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 through 7 of Bullock '857 in view of Hunter.

Claims 1, 3 through 5, 7, and 8 stand rejected under 35 U.S.C. § 103 as being unpatentable over Faulstich in view of Hunter.

The full text of the examiner's rejections and response to the argument presented by appellant appears in the main and supplemental answers (Paper Nos. 18 and 20), while the complete statement of appellant's argument can be found in the main (pages 5 through 17) and reply briefs (Paper Nos. 17 and 19).

In the main brief (page 5), appellant indicates that the claims on appeal do not stand or fall together. However, contrary to the view taken by the examiner in the answer (page 2), we find that only the subject matter of claim 1 is specifically argued in the brief (pages 10 and 13). We do note, however, that the argued limitations of claim 1 likewise appear in claim 5. In light of the above, we consider dependent claims 3 and 4 and dependent claims 7 and 8 to respectively stand or fall with their parent claims 1 and 5, which latter claims we focus upon below.

OPINION

In reaching our conclusion on the issues raised in this appeal, this panel of the board has carefully considered appellant's specification and claims,² the applied documents,³ the

² We note the following informality as regards claim 5, as amended during this reexamination proceeding. As is evident from page 4 of the patent owner's response filed June 9, 1994 (Paper (continued...))

declaration of Iain Gray (Paper No. 10), and the respective viewpoints of appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The obviousness-type double patenting rejection

We do not sustain this rejection.

Appellant's claims are drawn to the combination of a neck for a container formed of flexible plastic material comprising, inter alia, a straight, thin top flange slanting upwardly at an acute angle of approximately 20° from the horizontal

²(...continued)
No. 9), claim 5 was amended to have the subject matter of claim 6 incorporated therein. However, amended claim 5 in Paper No. 9, as well as claim 5 before us on appeal as shown in the appendix to the brief, lacks the recitation --to increase the flexibility of said flange-- following the recitation of "the inside of said neck being formed with an internal groove below said flange," as is present in original claim 6. We view this omission as simply a typographical error, which is deserving of correction during any further prosecution before the examiner. For appellate purposes, we shall view claim 5 before us as including the omitted recitation.

³ In our evaluation of the applied prior art references, we have considered all of the disclosure of each reference for what it would have fairly taught one of ordinary skill in the art. See In re Boe, 355 F.2d 961, 148 USPQ 507 (CCPA 1966). Additionally, this panel of the board has taken into account not only the specific teachings of each prior art reference, but also the inferences which one skilled in the art would reasonably have been expected to draw from the disclosure. See In re Preda, 401 F.2d 825, 159 USPQ 342 (CCPA 1968).

and an internal groove below the flange to increase the flexibility of the flange, and a cap having, inter alia, a disc, and inner and outer skirts depending from the discs, whereby when the cap is locked to the container neck the flange is depressed and seals against the underside of the disc and is dimensioned and positioned to slant upward-inward into the annular space between the skirts with the inner edge of the flange fitting tightly into the corner where the outside inner skirt intersects the underside of the disc.

The examiner relies upon claims 1 through 7 of Bullock '857 and Hunter to reject appellant's claims.

Claims 1, 2, 6, and 7 of the Bullock '857 patent are drawn to a cap per se. On the other hand, dependent claims 3 through 5 of of Bullock '857 include the subject matter of claims 1 and 2 and address the combination of a cap having, inter alia, a central top disc, a thin walled substantially cylindrical outer skirt and a short inner skirt each depending from the top disc, and the improvement comprising a pull tab for severing the outer skirt along a scoreline, and a container for the cap having, inter alia, a neck with an inturned flange with a horizontal flat lip.

The Hunter patent teaches the combination of a container and closure. The container (Figure 1) is fabricated from

plastic and is surmounted by a neck portion which includes, inter alia, a flexible flange 16 extending inward and upward. The flange includes a peripheral sealing surface 17 and peripheral edge 18. Each of the three types of disclosed closures (Figures 2, 7, and 8) includes a cover portion 20. As depicted in Figure 3, when the closure is applied to the container, cover portion 20 engages sealing surface 17 of flange 16 creating a seal. To "insure adequate sealing against leaking and/or sifting, it is preferred that flange 16 be depressed downward by cover portion 20 when a closure is snapped into place" (column 3, lines 18 through 20).

The examiner is of the view that it would have been obvious to remove specified features of the claimed cap and container combination of the Bullock '857 patent and to form the flange thereof slanting upwardly and inwardly, as taught by Hunter.

Simply stated, we are in accord with appellant's conclusion (main brief, pages 12 through 16, and reply brief, pages 6 through 10) that the invention now claimed is patentably distinct from the invention claimed in Bullock '857, and not merely an obvious variation thereof. More specifically, the difficulty we have with the examiner's obviousness determination

is that it entails what we consider to clearly be a hindsight-based reworking of the claimed subject matter of Bullock '857 based upon the present disclosure. Notwithstanding the circumstance that Hunter would have, in our view, been suggestive of enhancing sealing by use of an inwardly and upwardly extending flange, we cannot discern any motivation on the part of one having ordinary skill in the art for eliminating from the claims of the '857 patent what the patentee claims therein as the improvement in the cap, i.e., the pull tab for severing the outer skirt along a scoreline. Further, it does not appear that the examiner has appreciated that the claims of the '857 patent do not even concern themselves with a "flexible plastic material" container neck comprising a flange, as now claimed. For these reasons, we do not consider the claimed subject matter under review in this reexamination proceeding to be an obviousness-type double patenting of claims of the '857 patent.

The obviousness rejection under 35 U.S.C. § 103

We first address the evidence of obviousness applied in the examiner's rejection of claims 1, 3 through 5, 7, and 8 under 35 U.S.C. § 103.

Faulstich discloses (column 3, lines 36 through 46, and Figures 2 and 3) the combination of a neck for a container and a

cap that includes, inter alia, a horizontally inwardly turned flange 51 having a substantially flat top surface 52 dimensioned to fit against the underside of disc 16 of the cap 11 between the inner skirt 17 and outer skirt 21. The surface 53 is indicated to usually be somewhat ragged and does not form a "perfect seal" with the inner skirt 17.

The description of the Hunter patent, *supra*, is incorporated herein. We would only add the following from the Hunter disclosure. Hunter indicates (column 4, lines 41 through 52) that:

For example, flexible flange 16 may be disposed as shown in FIGURE 1 or it may be set at a right angle to the vertical axis of a container. . . . It is preferred that flange 16 be set at about 2° to 45° up from the horizontal.

In applying the test for obviousness,⁴ we reach the conclusion that it would have been obvious to one having ordinary skill in the art, from a combined consideration of the applied teachings, to replace the horizontally inturned flange of

⁴ The test for obviousness is what the combined teachings of references would have suggested to one of ordinary skill in the art. See In re Young, 927 F.2d 588, 18 USPQ2d 1089 (Fed. Cir. 1991) and In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Faulstich with an upwardly extending flexible flange, as taught by Hunter. From our perspective, the incentive on the part of an artisan for making this modification would have been to simply rely upon an alternative flange configuration known in the art to insure adequate sealing.

We are not persuaded by the argument advanced in the main and reply briefs that the examiner erred in rejecting appellant's claims under 35 U.S.C. § 103. Contrary to the view of appellant (main brief, pages 7 through 10, and reply brief, pages 2 through 4) we, like the examiner (answer, pages 5 through 7), have concluded that the references provide ample motivation or suggestion for their combination. Again, contrary to appellant's point of view (main brief, pages 8 and 9), we also do not consider the disclosure of a "permanent" snap-on closure in Hunter as detracting from the clear and unambiguous teaching of the flexible sealing flange. We also note, relative to appellant's commentary concerning the internal groove increasing the flexibility of the flange (main brief, page 10), that both Faulstich and Hunter teach a groove below the upper flange. As to Hunter specifically, it is our view that the groove below the flexible flange clearly would have been appreciated by one versed in the art as increasing the flexibility of the flange by its positioning below the flange.

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Appellant also points out (main brief, page 12) that both of the now applied references were applied by the examiner during the examination of the application from which the patent now being reexamined matured. However, as noted by the examiner (answer, page 8), and as the patented file reveals, the references were applied in different rejections and not together in one rejection as is now before us on appeal.

Secondary Considerations

As evidence of nonobviousness, appellant has submitted the Gray declaration in support of the asserted commercial success (main brief, pages 10 and 11 and reply brief, pages 5 and 6).

We recognize at this time that objective evidence of nonobviousness in any given case may be entitled to more or less weight, depending upon its nature and its relationship to the merits of a claimed invention. See Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 227 USPQ 657 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986). Additionally, for commercial success of a product embodying a claimed invention to have true relevance to the issue of nonobviousness, the success must be shown to have in some way been due to the nature of the claimed invention, as opposed to other economic and

commercial factors. This has been referred to as the nexus that is required between the merits of the claimed invention and the evidence offered, if the evidence is to be given substantial weight en route to a conclusion on an obviousness issue. See Cable Electric Products, Inc. v. Genmark, Inc., 770 F.2d 1015, 226 USPQ 881 (Fed. Cir. 1985). More than a mere showing that there was commercial success and that the commercially successful article embodied the invention is required. See, for example, In re Heldt, 433 F.2d 808, 167 USPQ 676 (CCPA 1970) and In re Noznick, 478 F.2d 1260, 178 USPQ 43 (CCPA 1973). What is required is a showing that the commercial success was due to the merits of the claimed invention, i.e., that the claimed features were responsible for the commercial success, if the evidence of nonobviousness is to be accorded substantial weight. See Ex parte Remark, 15 USPQ2d 1498 (Bd. Pat. App. & Int. 1990).

Appellant (main brief, page 10) relies upon declarant's statement (declaration, page 2) that an upward slanted flange at a neck opening provides a better seal. However, as evidenced by the clear teaching of Hunter, this better sealing characteristic (insures adequate sealing) of an upward slanted flange at a neck opening was well known to those having ordinary skill in the art prior to appellant's invention. The prior art teaching of Hunter is not addressed by declarant.

Declarant points out (declaration, page 2) that Portola Packaging, Inc. has been manufacturing an SC II cap for approximately 12 years, which cap may be used with the neck finish of the '066 patent (the patent undergoing reexamination) or a neck finish having a horizontal lip flange. Declarant describes the SC II cap as a plastic snap-on, snap-off cap. However, the declaration fails to indicate if the SC II cap corresponds to the cap, in the combination now claimed, which requires, inter alia, a disc and inner and outer skirts depending from the discs. In the reply brief (page 5), appellant indicates that the SC II cap manufactured by Portola Packaging, Inc. is "substantially identical" to the cap shown in the Figures of the patent. Of course, as indicated above, our concern is whether, in fact, the SC II cap corresponds to what is now being claimed.

Declarant further indicates (declaration, page 3) that approximately 90% of "dairies, bottlers, etc." purchasing SC II caps from appellant's assignee use bottles having the '066 neck finish rather than a neck finish having a horizontal lip flange. Declarant does not offer the specific reason or reasons why, in fact, the "dairies, bottlers, etc" use the neck finish of the patent. Thus, important economic and commercial factors relative to the dairies, bottlers, etc. themselves are not before us. Nevertheless, we perceive one circumstance for its use to be

entirely predictable, based upon the knowledge in the art (Hunter) at the time of appellant's invention. In our opinion, the dairies, bottlers, etc. may have simply appreciated the known insured adequate sealing advantage of a neck finish with an upward slanted flange.

At this point, we note that appellant's claims are broadly drawn to a container and cap combination, whereas declarant's focus is exclusively upon "dairies, bottlers, etc." and the use of "bottles." Even as to the mentioned dairies, bottlers, etc., we are not instructed as to what percentage of the overall container and cap market is addressed in the declaration. The sale of approximately three billion caps per year is impressive (declaration, page 3). But, as indicated, we are not informed as to what relative share of the overall container and cap market is reflected by the 90% of the dairies, bottlers, etc. that are indicated to use the claimed combination on "bottles." The absence of this latter information is critical since, as pointed out by the examiner in the supplemental answer, our focus relative to the claimed invention is the commercial success of the combination of the neck for a container formed of plastic material having an upwardly slanting top flange and cap with inner and outer skirts. In light of the above, we, like the

examiner (main answer, page 7, and supplemental answer), find that the declaration showing is lacking and does not establish the required nexus between the claimed subject matter and commercial success.

Considered in its entirety, and for the reasons articulated, supra, we can attribute little weight to appellant's showing of commercial success.

When we weigh the evidence of obviousness (the combined teachings of Faulstich and Hunter) with the evidence of non-obviousness (the Gray declaration), we reach the conclusion that the evidence of obviousness far outweighs the little weight accorded the evidence of nonobviousness. See In re Piasecki, 745 F.2d 1468, 223 USPQ 785 (Fed. Cir. 1984). Accordingly, the claimed invention is determined to be unpatentable under 35 U.S.C. § 103, and the examiner's rejection on this statutory ground is sustained.

In summary, this panel of the board has reversed the rejection of claims 1, 3 through 5, 7, and 8 under the judicially created doctrine of obviousness-type double patenting, and

affirmed the rejection of claims 1, 3 through 5, 7, and 8 under 35 U.S.C. § 103 as being unpatentable over Faulstich in view of Hunter.

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The decision of the examiner is affirmed.

Further prosecution in this case may be taken in accordance with 35 U.S.C. §§ 141 to 145 and 306, and 37 CFR §§ 1.301 to 1.304. Note also 37 CFR § 1.197(b). If the patent owner fails to continue prosecution, the reexamination proceeding will be terminated, and a certificate under 35 U.S.C. § 307 and 37 CFR § 1.570 will be issued canceling the patent claim(s), the rejection of which has been affirmed.

AFFIRMED

IRWIN CHARLES COHEN
Administrative Patent Judge

WILLIAM E. LYDDANE
Administrative Patent Judge

NEAL E. ABRAMS
Administrative Patent Judge

BOARD OF PATENT
APPEALS AND
INTERFERENCES

Appeal No. 95-4121
Application 90/003,230

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APPENDED CLAIM

5. In combination, a neck for a container formed of a flexible plastic material comprising a straight, thin top flange extending inward from the upper end of said neck, said flange slanting upwardly at an acute angle of approximately 20° from the horizontal, first locking means on said neck below said flange, a cap having a disc, an inner and an outer skirt depending from said disc, second locking means on said outer skirt cooperable with said first locking means, whereby when said first and second locking means are engaged said flange is depressed and seals against the underside of said disc, said flange being dimensioned and positioned to slant upward-inward into the annular space between said skirts with the inner edge of said flange fitting tightly against the outer surface of said inner skirt, said upper end of said neck having a short vertical external surface immediately below said flange, the inside of said neck being formed opposite said short vertical external surface with an internal groove immediately below said flange, the interior of said neck being formed with a substantially horizontal, inwardly directed surface immediately below said short vertical external shoulder, the interior of said outer skirt being formed with internal bead means forming part of said second locking means, said internal bead means having an upper surface immediately below said short vertical external surface which engages under said shoulder, the lower edge of said short, vertical external surface fitting against the inside of said skirt immediately above said internal bead means, said internal bead means restraining said lower edge against downward movement.